

REMARKS

At the time of the Office Action dated December 20, 2005, claims 1-13 were pending and rejected in this application. Claim 6 has been amended to address an informality.

THE REJECTION OF CLAIMS 1-9 AND 11-13 AND UNDER 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-9 and 11-13 is directed to non-statutory subject matter. This rejection is respectfully traversed.

In the statement of the rejection, the Examiner asserted the following:

A menu emulation method is not statutory at least for the reason that [sic] is not tangibly embodied in a manner so as to be executable.

The Examiner, however, has not cited any case law that supports the Examiner's conclusion that a method must be "tangibly embodied." Applicants are also unaware of any case law that supports the Examiner's conclusion. Thus, Applicants respectfully submit that the Examiner has failed to properly establish that the claimed invention, as recited in claims 1-9 and 11-13 is directed to non-statutory subject matter. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-9 and 11-13 under 35 U.S.C. § 101.

**CLAIMS 1-13 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY
RICHARD, U.S. PATENT NO. 6,954,903**

On pages 3-6 of the Office Action, the Examiner asserted that Richard discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met.

Claim 1 recites, in part, the following limitation: "encoding a form-submit element with a menu-item description and an associated graphical icon denoting a selectable menu." On page 3 of the Office Action, the Examiner asserted that this feature is disclosed by column 3, lines 41-48 of Richard. For ease of reference, this cited passage is reproduced below:

Basically, there is provided a process for displaying a composite object in a markup language page, which comprises at least two cells with a first cell containing an image and a second cell containing a textual information. The at least two cells are arranged in a table for the purpose of building a composite image wherein said textual information can be separately modified.

The Examiner's citation is found in the "Summary of the Invention" of Richard; and thus, the Examiner has made Applicants' analysis of the precise teachings of Richard being relied upon by the Examiner more difficult. Notwithstanding this handicap placed upon the Applicants by the Examiner, Applicants submit that the above identified passage fails to teach the claimed limitations for which this passage is being relied upon by the Examiner.

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

At the outset, Applicants note that the above-reproduced limitation includes the term "menu" in two instances: "a menu-line description" and "a selectable menu." Another limitation in claim 1 also uses the term "menu" for "a graphical menu-structure." Claim 2 includes three other limitations including the term "menu," and other instances of the term "menu" can be found throughout the other claims of the present Application. For example, independent claims 9-11 also introduce menu-related limitations such as "a selectable menu," "menu text," "a menu structure," and "a menu action," which are not identically disclosed by Richard. However, despite all these claimed limitations that include the term "menu," a textual search of Richard only yields one instance of the term "menu," and this is found in the very last sentence of the detailed description of Richard, which is merely a snippet of computer code. Applicants submit that this snippet of computer code does not identically disclose all of the different limitations that are associated with the term "menu." Moreover, the Examiner has failed to explain how all these menu-related limitations are identically disclosed by Richard since menu-related teachings are essentially absent in Richard. On these menu-related terms alone, Richard fails to identically disclose the claimed invention, as recited in claims 1 and 9-11, within the meaning of 35 U.S.C. § 102.

Claim 2 recites, in part, the following limitation: "embedding in a markup representation of said form-submit element, a network reference to a server configured to produce enhanced graphical menu images, said network reference comprising a textual menu-item description and a menu type." On page 3 of the Office Action, the Examiner asserted that this feature is disclosed by column 4, lines 64-67 of Richards. For ease of reference, these cited passage is reproduced below:

Therefore, only the basic textual information needs to be exchanged through the server and the user's equipment and all the user may change the look and feel of the presentation of the information.

Upon reviewing this passage cited by the Examiner, Applicants are unable to find a teaching of the claimed "network reference comprising a textual menu-item description and a menu type." The disclosure within Richard that "the user may change the look and feel of the presentation of the information" is not comparable to this limitation. Thus, Richard further fails to identically disclose all the limitations recited in claim 2.

Claim 3 recites, in part, the following limitation: "embedding said encoded form-submit element in network distributable markup defining a table cell in a table." On page 3 of the Office Action, the Examiner asserted that this feature is disclosed by column 4, lines 19-28 of Richards.

For ease of reference, this cited passage is reproduced below:

For the purpose of generating a set of automatically aligned and positioned objects, which are easily editable, the process takes advantage of the properties of the HTML table and allows an easy construction of an HTML page which contains a set of vertically aligned or horizontally aligned buttons which can be read by any web browser, even of the early generation. The different subfiles of the buttons are arranged in a set of tables, based on 3x3 cells, with the middle comprising the textual information to be incorporated within the considered graphical button.

Upon reviewing this passage cited by the Examiner, Applicants are unable to find a teaching of the claimed "embedding said encoded form-submit element in network distributable markup defining a table cell in a table." Richard describes that that "each graphical object or button is represented by a set of 3 rows and three columns forming 9 elementary cells" (column 8, lines 1-3). However, whereas the claimed invention recites that the encoded form-submit element is embedded in a table cell (i.e., a single cell) of a table, Richard describes that multiple cells are used for each graphical element. Thus, Richard further fails to identically disclose all the limitations recited in claim 3.

Claim 4 introduces the concept of formatting a table cell with a background color that differs from the background colors of other table cells. To teach this limitation, the Examiner relied upon column 5, lines 53-62. However, upon reviewing this passage, Applicants are unable to determine where this limitation is identically disclosed by Richard. Moreover, column 5, lines 53-62 further fails to teach the claimed "replacing said encoded form-submit element embedded in said table cell with said graphical menu-structure." Thus, Richard further fails to identically disclose all the limitations recited in claim 4.

With regard to claim 5, the Examiner cited column 8, lines 41-52. However, none of the disclosure found within these passages is directed to a table cell in a table row. As already noted above, Richard teaches that each graphical object or button is associated with its own table. Thus, whereas the claimed invention recites that multiple encoded form-submit elements can be embedded within a single table, Richard teaches that a single graphical object is associated within a single table. Thus, Richard further fails to identically disclose all the limitations recited in claim 4.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1-13 under 35 U.S.C. § 102 for anticipation based upon Richard is not factually viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the

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prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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